

REMARKS

35 USC § 102(b)

Claims 9-14 were rejected under 35 USC § 102(b) as being anticipated by Rudolph (U.S. Pat. No. 4,161,393). The Applicant respectfully disagrees, especially in view of the amendments herein.

(1) The office noted on page 2 of the present office action that "...The preamble language of 'a method for reducing steam consumption' is not given any patentable weight..." It is unclear to the applicant on what basis the office could take such position.

A preamble is entitled to patentable weight when it is "necessary to give life, meaning, and vitality" to the claim (*Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999)). The Federal Circuit has held that a preamble may give "life, meaning and vitality" to a claim either: (1) explicitly (the claim expressly uses the preamble and the body of the claim to define the claimed invention); or (2) implicitly (proper construction of the claim requires reference to the preamble). Consequently, where the body of a claim and the preamble is used to define the claimed subject matter, the preamble must be accorded patentable weight.

In the instant case, the claim preamble (...A method of reducing steam consumption...) and the body of the claim (...wherein the second portion is combined with the first shift reactor effluent in an amount effective to reduce steam consumption...) expressly define the invention. Consequently, the claim preamble must be considered in its entirety and the element of "method of reducing steam consumption" can not be properly ignored.

(2) Claim 9 was further amended to expressly require that "...the steam is the only source of water added to the first portion ...", which is not taught in the '393 patent. It is noted that the examiner argued that the '393 patent would teach "...combining only the first portion with steam (in 10)... (page 3, lines 5-6). This is simply not correct. Item 10 is a saturator that operates as a countercurrent contact device in which the rising raw gas is contacted with condensate (11) from the effluent cooler (26). While this may appear to be a fine point, it is noted that condensate can at best saturate the raw gas (which is exactly what Rudolph teaches) whereas addition of steam

allows addition of water in quantities well above the saturation point. Moreover, steam will have a temperature that is necessarily above the boiling point whereas the temperature of condensate is necessarily below the boiling point.

(3) The office also appeared to argue that the second portion of Rudolph's raw gas would be "...combined with the first shift reactor effluent in an amount effective to reduce steam consumption..." and pointed in support to col. 1, lines 20-25 in the '393 patent. However, quite the opposite is provided in this passage as Rudolph teaches that "... The addition of steam can be avoided or much reduced *if the raw gas* produced by the pressure gasification of coal *is saturated with water vapor* before it is fed to the shift conversion equipment..." Clearly, Rudolph attributes the saturator 10 with the steam reduction, which is entirely inconsistent with the claimed subject matter.

35 USC § 103(a)

Claim 15 was rejected under 35 USC § 103(a) as being obvious over Rudolph in view of Schmid (U.S. Pat. No. 4,159,236). The Applicant again respectfully disagrees.

With respect to Rudolph, the same considerations and arguments as discussed above apply and are therefore not reiterated here. While the applicant agrees that Schmid teaches an acid gas removal unit to produce a fuel gas, Schmid fails to remedy the defects in Rudolph as pointed out above. Consequently, the rejection of claim 15 as being obvious over Rudolph in view of Schmid should be withdrawn.

REQUEST FOR ALLOWANCE

Claims 1-15 are pending in this application with claims 1-8 being withdrawn. The applicant requests allowance of all pending claims.

Respectfully submitted,
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